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Article

***659** TODAY'S SCANDAL CAN BE TOMORROW'S VOGUE: WHY SECTION 2(A) OF THE
LANHAM ACT IS UNCONSTITUTIONALLY VOID FOR VAGUENESSRobert H. Wright [\[FNa1\]](#)

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*660 INTRODUCTION

A trademark serves any number of important functions for a seller. Its most important purpose, however, is to identify a seller's goods and distinguish them from others being sold in the marketplace. By doing this, consumers are given the opportunity to make purchasing decisions based upon their past experience with a product. Indeed, “[h]umans have a psychological momentum to continue doing the same things in the same way as was done in the past. Buying habits are no exception. There is a comforting security in returning to a product or service with which one is familiar.” [FN1] Ultimately, then, the strength of a seller's trademark and the profits he receives from selling the product associated with that trademark are interrelated. Given this correlation, it is understandable that a seller would want to provide his trademark with the greatest amount of legal protection as is possible.

While trademark rights are protected at common law, the greatest amount of legal protection available for a seller's trademark is provided by the Lanham Act. [FN2] This Statute requires a seller to register his trademark with the U.S. Patent and Trademark Office (PTO) before he is able to enjoy the extensive protection of federal registration. [FN3] However, not every trademark may be registered with the PTO. Section 2(a) of the Lanham Act, for example, prohibits the registration*661 of those trademarks found to be “scandalous” or potentially “disparag[ing].” [FN4] Although much time has been spent litigating the issue, exactly what types of trademarks fall within the potentially boundless scope of this Section has yet to be determined adequately.

The purpose of this Article is to consider Section 2(a) against the Void for Vagueness Doctrine and its Supreme Court jurisprudence. More specifically, this Article argues that Section 2(a) is impermissibly vague, and, if challenged, would be found to be unconstitutional. Part I of this Article begins by providing an overview of the substantive elements of the Void for Vagueness Doctrine, as well as the policy considerations shaping the Court's void for vagueness jurisprudence. Part II continues by discussing the federal registration process, traditional interpretations of “scandalous” and “disparage,” and prior void for vagueness challenges to Section 2(a). Part III then concludes by arguing that the failure of the judiciary to provide adequate meaning to that Section's inherently vague language has ultimately resulted in Section 2(a) being unconstitutionally void for vagueness.

I. THE VOID FOR VAGUENESS DOCTRINE

The roots of the Void for Vagueness Doctrine lie in the Due Process Clauses of the Fifth and Fourteenth Amendments. [FN5] Simply put, the doctrine requires specificity in the drafting of statutory language. The classic statement of the rule, however, is a bit more precise. As explained by the Court in *Conally v. General Construction Company*, [FN6] “a statute which either forbids or requires the doing of an act in terms so vague that men of common intelligence must necessarily guess at its meaning and differ as to its application violates the first essential due process of law.” [FN7] That is not to say that a statute will not pass constitutional muster simply because it might have been drafted more precisely. [FN8] On the contrary, the Court has continuously held that the *662 Constitution does not require impossible standards of statutory clarity. [FN9]

A. Substantive Elements

Before a law will be found unconstitutional under the Void for Vagueness Doctrine, two substantive requirements must be met. First, a showing must be made that the challenged statute fails to provide adequate notice of the conduct which it prohibits. [FN10] Second, evidence must be presented to show that the law in question has the potential to be enforced arbitrarily and discriminatorily. [FN11]

1. Notice

The notice requirement of the Void for Vagueness Doctrine is based upon the concept of *nulla poena sine lege*, which requires the state to define criminal conduct adequately before punishing it. [FN12] Rooted initially “in a rough idea of fairness,” [FN13] the Court has subsequently elevated this doctrine to that of a constitutional guarantee required under both the Fifth and Fourteenth Amendments. [FN14] As the Court noted in *Cline v. Frink Dairy Company*, [FN15] due process “certainly impose[s] upon [government] an obligation to frame . . . criminal statutes so that those to whom they are addressed may know what standard of conduct is intended to be required.” [FN16]

The requirement that the state provide adequate notice of prohibited conduct, however, is not an impossible burden to meet. [FN17] A statute will not be found to be void for vagueness due to lack of sufficient notice simply because the state might have drafted it more precisely. [FN18] Rather, the type of notice contemplated by the Void for Vagueness Doctrine is only meant to ensure that the state has established*663 “minimal guidelines to govern law enforcement.” [FN19] As the Court explained in *Colten v. Kentucky*, [FN20] the notice requirement is not “designed to convert into a constitutional dilemma the practical difficulties in drawing criminal statutes both general enough to take into account a variety of human conduct and sufficiently specific to provide fair warning that certain kinds of conduct are prohibited.” [FN21] Thus, a law will be found to meet the notice requirement of the Void for Vagueness Doctrine if either its plain language or judicial construction articulate sufficiently the reach and meaning of the statute. [FN22]

2. Arbitrary and Discriminatory Enforcement

The Court has long disdained the arbitrary use of state power. [FN23] As the Court noted in *Hurtado v. California*, [FN24] “[a]rbitrary power, enforcing its edicts to the injury of the persons and property of its subjects, is not law, whether manifested as the decree of a personal monarch or of an impersonal multitude.” [FN25] The Void for Vagueness Doctrine's formal requirement that evidence of potential arbitrary and discriminatory enforcement be shown, however, is a modern development. [FN26] In fact, only recently, in the case of *Kolender v. Lawson*, [FN27] did the Court formally recognize that the primary function of the Void for Vagueness Doctrine is to prevent the arbitrary and discriminatory enforcement of the law. [FN28] In *Kolender*, the Court considered a facial challenge to a California statute that allowed police officers to stop and request identification from loiterers without any justification. [FN29] After concluding that the statute arbitrarily restricted otherwise lawful conduct, the Court found that the statute was unconstitutionally void for vagueness. [FN30]

*664 B. Policy-Based Elements

In addition to the substantive elements of notice and arbitrary and discriminatory enforcement, a historical consideration of void for vagueness jurisprudence reveals several distinct policies underlying the application of the doctrine. The most definite of these themes is the Court's disapproval of "basic policy matters" [FN31] being delegated to unelected officials for resolution. Other more subtle considerations, though, are equally as important to the ultimate success of a void for vagueness challenge. Indeed, when considering the vagueness of statutory language, the Court will also consider whether the challenged provision implicates the First Amendment, whether the challenged provision provides for a civil or criminal penalty, and whether the challenged provision is of state or federal origin. [FN32]

1. Principal Considerations

The clearest statement regarding the purpose of the Void for Vagueness Doctrine is found in *Grayned v. City of Rockford*. [FN33] In *Grayned*, the Court explained that the doctrine serves two principal functions:

[First] [v]ague laws may trap the innocent by not providing fair warning. Second, if arbitrary and discriminatory enforcement is to be prevented, laws must provide explicit standards for those who apply them. A vague law impermissibly delegates basic policy matters to policemen, judges, and juries for resolution on an ad hoc and subjective basis, with the attendant dangers of arbitrary and discriminatory application. [FN34]

As the Court further explained in *Roberts v. United States Jaycees*, [FN35] "[t]he requirement that [the] government articulate its aims with a reasonable degree of clarity ensures that state power will be exercised only on behalf of policies reflecting an authoritative choice among competing . . . values." [FN36] Thus, at its most fundamental level, the Void for Vagueness Doctrine acts as a judicial restraint on the state's otherwise unchecked ability to legislate conduct. [FN37]

*665 2. First Amendment Matters

Historically, the Court has been particularly quick to apply the Void for Vagueness Doctrine to legislation which negatively impacts an individual's First Amendment rights out of fear that such laws might chill otherwise constitutionally protected speech. [FN38] This is because "[u]ncertain meanings inevitably lead citizens to 'steer far wider of the unlawful zone' . . . than if the boundaries of the forbidden areas were clearly marked." [FN39] As the Court noted in *NAACP v. Button*, [FN40] freedom of expression "[is] delicate and vulnerable, as well as supremely precious in our society. [And,] [t]he threat of sanctions may deter their exercise almost as potently as the actual application of sanctions." [FN41] The Court further explained that "[S]tandards of permissible statutory vagueness are strict in the area of free expression Because First Amendment freedoms need breathing space to survive, government may regulate in the area only with narrow specificity." [FN42]

3. Civil Law-Criminal Law Distinction

Void for vagueness jurisprudence also shows that the Court has traditionally reserved application of the Doctrine for laws that impose only the harshest of penalties upon those who deviate from their terms. [FN43] That is, the more severe the penalty imposed by a statute, the more likely the Court is to invalidate it on void for vagueness grounds. [FN44] As such, the doctrine has been liberally ap-

plied to criminal statutes. [FN45] However, where the severity of the penalty is decreased, the Court is more likely to uphold the challenged law as constitutional. [FN46] That is not to say that the doctrine is entirely inapplicable in the civil context. Rather, the Court long ago stated that “[i]t [is] not the criminal penalty that [is] held invalid, but the exaction of obedience to a rule or standard which [is] so vague and indefinite as really to be no rule or standard at all.” [FN47]

*666 4. State Law-Federal Law Distinction

The Court will also consider whether the challenged provision is a creation of the state or federal government. [FN48] The former have been regularly overturned on void for vagueness grounds. [FN49] On the other hand, congressional legislation is much more likely to survive a challenge under this doctrine. [FN50] When examining a state law for vagueness, the Court will consider the language of the statute as authoritatively construed by the highest court of that state. [FN51] However, when evaluating acts of Congress, the Court is free to employ its own interpretive power so as to limit vague statutory language. [FN52] Most often, the Court has found meaning in otherwise vague statutory language in prior judicial constructions of the language at issue or the legislative history of the statute itself. [FN53] In the absence of such guidance, the Court has rejected challenges brought under the doctrine where a common sense interpretation of the statutory language clearly explains the proscribed conduct. [FN54]

II. SECTION 2(A) OF THE LANHAM ACT

The federal registration of trademarks is governed by the Lanham Act. [FN55] Not every trademark is registerable under the Act. For example, Section 2(a) prohibits the registration of trademarks which are deemed to be “scandalous” or potentially “disparag[ing].” [FN56] Exactly what types of trademarks fall within the broad brush of this Section has long been debated. [FN57] Although much time has been spent litigating the issue, an applicant can be no more certain that his trademark will survive scrutiny under Section 2(a) today than he would have been when the Lanham Act was first passed into law fifty-seven *667 years ago. Indeed, the inherently vague language of Section 2(a), along with the inability of those interpreting that Section to formulate a single standard against which to consider the character of an applicant's trademark, have only further confused the matter.

A. The Registration Process

A cursory understanding of the federal registration process is helpful before considering the substance of the Lanham Act itself. The process begins when an application is filed with the U.S. Patent and Trademark Office (PTO). [FN58] Upon arrival at the PTO, an examining attorney is assigned to review the application. [FN59] The purpose of this ex parte inquiry is two-fold. [FN60] The initial focus of the examining attorney is to determine whether the application meets the procedural requirements for registration. [FN61] If it does not, the application is returned to the applicant for correction. [FN62] An application properly filed, on the other hand, is further scrutinized by the examining attorney. [FN63] Here, the focus of the inquiry is not on the application, but rather on the proposed trademark and whether any substantive bars to registration prohibit its placement on the Principal Register. [FN64] If the trademark is found to be unregistrable, the application is rejected and returned to the applicant with an explanation of the examining attorney's decision. [FN65]

After a trademark has been rejected initially by the PTO, the applicant is given an opportunity to respond to the examining attorney's arguments against registration. [FN66] This response generally takes one of two forms. [FN67] Most often, an applicant will use this opportunity to offer alternative legal arguments in support of his trademark's registration.*668 [FN68] Other times, however, an applicant will just provide the PTO with additional evidentiary submissions regarding the prior use of his trademark. [FN69] After considering the applicant's response, the examining attorney re-evaluates the applicant's trademark and again issues a decision regarding the registration to which the applicant is again allowed to respond. [FN70] This back-and-forth process continues until either the applicant abandons his application, the PTO issues a final rejection, or the examining attorney approves the proposed trademark. [FN71]

After an applicant's trademark is approved by the examining attorney, public notice is given in the PTO's Official Gazette, and registration on the Principal Register is generally issued within six months thereafter. [FN72] Approval by the PTO, however, is only the first hurdle an applicant must overcome before his trademark is placed on the Principal Register. [FN73] Once notice of a trademark's pending registration is given, members of the general public are allowed thirty days to challenge final registration of the applicant's trademark formally. [FN74] This is done by instituting an action referred to as an opposition with the Trademark Trial and Appeal Board (TTAB) that may be brought for any of the reasons prohibiting federal registration articulated by the Lanham Act, or if the challenger feels he will somehow be harmed by the trademark's placement on the Principal Register. [FN75]

Even for those trademarks ultimately rejected by the PTO, the registration process is far from over. An applicant who is dissatisfied with an examining attorney's review of his trademark may appeal the PTO's final rejection to the TTAB. [FN76] In such an action, the applicant files a brief in support of his trademark's placement on the Principal Register. [FN77] The PTO, acting through the examining attorney who previously denied registration of the applicant's trademark, then files a response in support of its rejection. [FN78] The applicant, however, has the last say before the TTAB as he is allowed to file another shorter brief *669 in response to any arguments raised by the PTO in its response. [FN79] Once all of the briefs have been filed, the TTAB then considers the merits of the case and offers a decision in regards to the registration of the applicant's trademark. [FN80] If this decision does not favor the applicant, he may then appeal to either the Federal Circuit or any federal district court in the United States. [FN81] If the latter alternative is chosen, the matter may theoretically end up before the U.S. Supreme Court. [FN82]

B. Section 2(a)

Upon first glance, the terms of Section 2(a) appear simple. That Section provides, in pertinent part:

No trademark . . . shall be refused registration on the principal register on the account of its nature unless it-

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute [FN83]

Historically, however, application of Section 2(a) has been decidedly more difficult, due in part to the broad scope of that Section's key terms. As the Lanham Act itself is silent as to the meaning of terms like “scandalous” and “disparag[ing],” it is not surprising that much time has been spent litigating the issue. Despite the use of dictionaries and the creation of multifactor tests, applicants today are just as uncertain as to the scope of Section 2(a) as they were when the Lanham Act was first passed fifty-seven years ago. [FN84]

1. “Scandalous” Defined

Most courts interpreting “scandalous” as used in Section 2(a) have done so by acquiescing to the definition of that term articulated in *In re Riverbank Canning Co.* [FN85] In that case, the Court of Customs and Patent Appeals (CCPA) was asked to consider whether the trademark “MADONNA,” in association with wine, was scandalous under *670 Section 5(a) of the Trade-Mark Act of 1905. [FN86] Noting that “[t]he word ‘scandalous’ is in common use, and its meaning is well understood,” [FN87] the court defined the term according to the meaning provided by popular dictionaries. [FN88] According to these sources, “scandalous” meant “[c]ausing or tending to cause scandal; shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable” [FN89] and “[g]iving offense to the conscience or moral feelings; exciting reprobation; calling out condemnation.” [FN90] Based upon these definitions, the CCPA held that the applicant's trademark was scandalous and as such it was denied federal registration. [FN91]

Not all courts, though, have chosen to adhere to the definitions articulated by the CCPA in *Riverbank Canning*. [FN92] Recently, at least two courts have turned to more contemporary dictionaries for a more modern interpretation of “scandalous.” [FN93] For example, the court in *Bromberg v. Carmel Self Service, Inc.* [FN94] held that scandalous trademarks are those that “‘giv[e] scandal,’” [FN95] create “‘the distressing effect on others of unseemly or unrighteous conduct’” [FN96] or offend “‘established moral conception or disgraces all who are associated or involved.’” [FN97] Thus, the trademark, “ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND,” for restaurant services, was denied registration. [FN98] Other courts have defined the term as being “offensive to a segment of the public sense of propriety or morality.” [FN99] Using this definition, the court, in *In re Runsdorf*, [FN100] denied registration of the trademark “BUBBY TRAP” in association with brassieres. [FN101]

Dictionaries have not been the only resource used to define “scandalous.” Frustrated with the lack of precision with which these *671 sources define the term, the Federal Circuit has adopted a three-pronged test for “scandalous[ness].” [FN102] As articulated by the court in *In re Mavety Media Ltd.*, [FN103] a trademark is scandalous if

- (1) the mark [is] shocking to the sense of truth, decency, or propriety, or call[ing] out for condemnation;
- (2) the mark [is] considered in the context of the marketplace as applied to only the goods or services in the application for registration; and
- (3) the mark [is] scandalous to a substantial composite of the general public, as measured from the context of contemporary attitudes. [FN104]

Under this test, the trademark at issue in *Mavety Media*, “BLACK TAIL,” in association with an adult magazine featuring African American women, was found to be scandalous within the meaning of Section 2(a), and thus, was denied placement on the Principal Register. [FN105]

2. “Disparag[ing]” Defined

While much time has been spent litigating the meaning of “scandalous,” surprisingly little attention has focused on better defining Section 2(a)'s use of the term “disparage.” [FN106] Indeed, it was only recently, in *Greyhound Corp. v. Both Worlds, Inc.*, [FN107] that the TTAB defined that term. [FN108] In that case, the TTAB explained that:

[d]isparagement is essentially a violation of one's right of privacy - the right to be “let alone” from contempt or ridicule . . . [t]he two elements of such a claim are (1) that the communication reasonably would be understood as referring to the plaintiff; and (2) that the communication is disparaging, that is, would be considered offensive or objectionable by a reasonable person of ordinary sensibilities. [FN109]

Applying this test, the TTAB concluded that the applicant's trademark, a silhouette of a defecating dog as a logo on polo shirts, *672 was found to be potentially disparaging of Greyhound's running dog trademark. [FN110] Thus, the proposed trademark was denied registration under Section 2(a). [FN111]

C. Prior Challenges to Section 2(a)

Given its broad language, it is not surprising that Section 2(a) has been constitutionally challenged on void for vagueness grounds. To date, however, these challenges have been wholly unsuccessful.

1. In re McGinley

The first constitutional challenge to Section 2(a) came in *In re McGinley*. [FN112] In *McGinley*, the PTO denied registration of a trademark consisting of “a photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia,” [FN113] in association with an adult newsletter. [FN114] The court reached this decision after affirming the PTO examiner's finding that “[s]uch activities are considered deviations from the sexual norm of husband and wife relations,” [FN115] and that “[t]he mark graphically indicates the activity carried on in applicant's Club; sex not normally sanctioned by . . . social standards.” [FN116] The decision was affirmed by the TTAB, and *McGinley* subsequently appealed to the CCPA. [FN117] Before the CCPA, *McGinley* argued “that [S]ection 2(a) is constitutionally ‘void for vagueness’ because there is no satisfactory definition for the words immoral or scandalous, there have been no guidelines or standards established, and, as in obscenity cases, it is not possible to formulate a national standard.” [FN118] Ultimately, however, the CCPA disagreed. [FN119]

In reviewing *McGinley*'s void for vagueness challenge, the CCPA began its analysis by noting that the “limited statutory right to registration . . . cannot be denied without compliance with Fifth Amendment due process requirements.” [FN120] The court further explained that protection of these rights “entails a determination of whether the term *673 ‘scandalous’ is sufficiently precise to enable the PTO and the courts to apply the law fairly and to notify a would-be registrant that the mark he adopts will not be granted federal registration.” [FN121] After briefly alluding to prior cases in which other sections of the Lanham Act have withstood similar constitutional challenges, the court summarily rejected *McGinley*'s claim. [FN122] Noting that the Void for Vagueness Doctrine only requires

“‘definite warning as to the proscribed conduct when measured by common understanding and practices,’” [FN123] the CCPA held that “the term ‘scandalous’ is sufficiently precise to satisfy due process requirements.” [FN124]

2. In re Mavety Media Group Ltd.

The CCPA's holding in McGinley would stand for thirteen years until Section 2(a) was again challenged under the Void for Vagueness Doctrine in Mavety Media. In that case, the publisher of “an adult entertainment magazine featuring photographs of both naked and scantily-clad African[]American women,” [FN125] applied for registration of the trademark “BLACK TAIL.” [FN126] Relying “upon a dictionary defining ‘tail’ as ‘SEXUAL INTERCOURSE-- usu[ually] considered vulgar,’” [FN127] Mavety Media's trademark was initially rejected by the PTO because it “consist[ed] of or compris[ed] immoral or scandalous matter.” [FN128] Mavety Media responded by arguing that “‘a large number of consumers would interpret “BLACK TAIL” as a reference to a type of evening coat or the full evening dress worn by men at formal occasions.’” [FN129] The trademark was ultimately rejected by the PTO, however, which reasoned that “a substantial composite of the general public would have reason to consult a dictionary and as such become aware of new definitions of words which may in the past [have] had [vulgar] slang meanings but are now defined in standard dictionaries.”*674 [FN130] This decision was later affirmed by the TTAB in a two-to-one decision. [FN131] Mavety Media then appealed to the Federal Circuit. [FN132]

On appeal, Mavety Media argued that Section 2(a) “is a facially unconstitutional abridgement of [his] freedom of speech guaranteed by the First Amendment, or alternatively that the Board applied [Section 2(a)] in an unconstitutionally arbitrary manner.” [FN133] Like the TTAB below, however, the Federal Circuit disagreed. [FN134] Relying on the CCPA's holding in McGinley, the court held that “our precedent forecloses Mavety's challenges to [Section 2(a)] as unconstitutional on its face or as applied.” [FN135] “‘Consequently, [the] appellant's First Amendment rights would not be abridged by the refusal to register his mark.’” [FN136] The Federal Circuit also held that “the statutory test for [the Section 2(a)] prohibition of scandalous matter is [not] so vague as to arbitrarily violate [Mavety Media's] constitutional rights to due process of law.” [FN137] Ultimately, however, the Federal Circuit vacated the TTAB's decision for further proceedings. [FN138]

3. Pro-Football, Inc. v. Harjo

Six years after the Federal Circuit's decision in Mavety Media, Section 2(a) was again challenged on void for vagueness grounds in Harjo v. Pro-Football, Inc. [FN139] In Pro Football, a class of Native Americans, led by Susan Harjo, initiated cancellation proceedings against the Washington Redskins. [FN140] Harjo claimed that the team's use of the trademark, “REDSKINS,” “is a pejorative, derogatory, degrading, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation for a Native American person.” [FN141] Pro-Football, on behalf of the Washington Redskins, raised several defenses, including “that . . . Section 2(a) of the Lanham Act . . . is unconstitutionally void *675 for vagueness.” [FN142] After concluding that reviewing the constitutionality of Congressional legislation was “beyond [its] authority,” [FN143] the TTAB refused to address Pro-Football's constitutional arguments. [FN144] Five years after Harjo's initial challenge, the TTAB issued a cancellation order for the contested trademark after finding that its use might disparage Native Americans. [FN145]

The TTAB's decision was subsequently appealed by Pro-Football to the U.S. District Court for the District of Columbia. [FN146] There, Pro-Football raised the claim that “[S]ection 2(a) is unduly vague in violation of the Fifth Amendment.” [FN147] Despite acknowledging that “Pro-Football's Fifth Amendment claim is novel because no court has considered whether the Lanham Act's prohibition on trademarks that ‘may disparage’ people is so vague as to deny due process,” [FN148] the court refused to address Pro-Football's constitutional challenge. [FN149] Instead, the court chose to “tackle [Pro-Football's First and Fifth Amendment claims] only if [it] does not prevail on its non-constitutional claims [because of the avoidance doctrine].” [FN150] After considering its non-constitutional claims, the court reversed the TTAB's cancellation of the trademark “REDSKINS” on the basis that “the doctrine of laches precludes consideration of the case.” [FN151] Thus, Harjo's action was dismissed, and Pro-Football's void for vagueness challenge was rendered moot. [FN152]

III. SECTION 2(A) IS UNCONSTITUTIONALLY VOID FOR VAGUENESS

Initially, McGinley and Mavety Media appear determinative on the issue of whether Section 2(a) is unconstitutionally void for vagueness. A closer analysis of these cases, though, shows that the issue has yet to be properly adjudicated. In McGinley, the CCPA concluded *676 that Section 2(a) was not unconstitutionally vague without referencing any of the factors traditionally considered in such an analysis. [FN153] Such a cursory review clearly goes against the great weight of the Court's void for vagueness jurisprudence. [FN154] The Federal Circuit's holding in Mavety Media is similarly flawed because the court in that case relied solely upon McGinley when summarily dismissing the applicant's void for vagueness challenge. [FN155] Since the CCPA's holding in McGinley is flawed, the Federal Circuit's decision in Mavety Media is similarly tainted. As such, Section 2(a) has never been scrutinized properly under the Void for Vagueness Doctrine. Once Section 2(a) is thoroughly analyzed, it will undoubtedly be found unconstitutionally void for vagueness.

A. Substantive Elements

As discussed in Part I, there are two substantive elements to the Void for Vagueness Doctrine: (1) notice; and (2) arbitrary and discriminatory enforcement. [FN156] Because those interpreting the terms of Section 2(a) have failed to articulate a single standard against which the character of an applicant's trademark is to be weighed, that Section, as it currently exists, fails to satisfy the substantive requirements of the Void for Vagueness Doctrine.

1. Notice

The type of notice contemplated by the Void for Vagueness Doctrine is only meant to “‘establish minimal guidelines to govern law enforcement.’” [FN157] The Lanham Act is silent as to the meaning of “scandalous” and “disparag[ing]” as used in Section 2(a). [FN158] As such, those interpreting that Section have been forced to give meaning to these inherently vague terms by referencing dictionaries and creating multifactor tests. [FN159] This approach, however, has ultimately failed to provide the minimal guidelines required by the Void for Vagueness *677 Doctrine. Indeed, the various definitions and approaches adopted by those considering the terms of Section 2(a) have only further confused the meaning of that Section. As such, the plain language of Section 2(a) and the jurisprudence interpreting that Section, as it currently exists, fail the notice requirement of the Void for Vagueness

Doctrine.

In the absence of congressional guidance, those interpreting the terms of Section 2(a) have turned to dictionaries for assistance. [FN160] This approach, however, has done little to breathe meaning into the otherwise lifeless terms of that Section, as many times the definitions offered by these sources are just as abstract as the term itself. Indeed, splitting hairs between “scandalous” and “morally offensive” does little to establish the de minimis standards required by the Void for Vagueness Doctrine as the meaning of these terms ultimately depends upon the who, what, when, where, and how they are being used. To date, however, those interpreting Section 2(a) have failed to agree on even these simple questions. [FN161] Until these matters are reconciled and a single standard for “scandalous[ness]” and “disparage[ment]” is articulated, a prospective applicant has very little guidance as to whether his trademark will survive scrutiny under Section 2(a).

Reliance on the multi-factor tests articulated in *Mavety Media* and *Greyhound Corp.* is similarly flawed. Although these tests do narrow the scope of Section 2(a) beyond that of reference to dictionary definitions alone, the elements of these tests encourage those judges considering potential violations of that Section to determine subjectively the character of an applicant's trademark. [FN162] The use of these tests is further problematic because it blurs the standard against which Section 2(a) determinations are to be made. That is, when considering the character of an applicant's trademark, it is now unclear whether the decision to deny registration to a trademark under Section 2(a) should turn on a dictionary definition, the *Mavety Media* or *Greyhound Corp.* test, or both. Until this matter is clarified, an applicant*678 can have no way of knowing whether his trademark is “scandalous” or potentially “disparag[ing]” within the meaning of Section 2(a).

Although many attempts have been made at defining its terms, the actual scope of Section 2(a) is still unclear. Until a single standard is established against which to measure the character of an applicant's trademark, the application of that Section ultimately turns on the subjective judgment of those responsible for evaluating an applicant's trademark. Indeed, the TTAB itself has noted that “the guidelines for determining whether a mark is scandalous or disparaging are ‘somewhat vague’ and, the ‘determination [of whether] a mark is scandalous [or disparaging] is necessarily a highly subjective one.’” [FN163] Such a capricious application of Section 2(a) is fundamentally unfair to an applicant because it deprives him of reasonable notice as to whether his trademark will be rejected by the PTO. Thus, Section 2(a) violates the notice requirement of the Void for Vagueness Doctrine.

2. Arbitrary and Discriminatory Enforcement

The failure of those considering Section 2(a) to establish a single standard against which to measure the scandalousness or potential disparagement of an applicant's trademark has ultimately resulted in that Section's arbitrary and discriminatory application. Indeed, Section 2(a) jurisprudence, as a whole, is ripe with examples of such capriciousness. [FN164] Only a few cases, though, need to be discussed to prove *679 sufficiently that Section 2(a) fails the second substantive element of the Void for Vagueness Doctrine. That is, the historically arbitrary and discriminatory enforcement of Section 2(a) is sufficiently evidenced for purposes of the Void for Vagueness Doctrine when *In re In Over Our Heads, Inc.* [FN165] is compared with *In re P.J. Valckenberg, GmbH*, [FN166] and *In re Steven Hershey* [FN167] is contrasted with *In re Runsdorf*. [FN168]

Section 2(a) jurisprudence is ripe with examples of arbitrary enforcement. Take, for example, the cases of *In Over Our Heads* and *P.J. Valckenberg, GmbH*. In the case of *In Over Our Heads*, the trademark “MOONIES” was denied registration by the PTO “on the basis that the mark comprises scandalous matter which disparages the Unification Church founded by the Reverend Sun Myung Moon.” [FN169] More specifically, the PTO concluded that “[the] applicant’s mark is ‘lacking in taste and is an affront to an organized religious sect’ because the second and third letters in the applicant’s mark form the ‘caricature of naked buttocks’ and because the mark is used on dolls whose pants can be dropped, thus exposing their buttocks.” [FN170] On appeal, however, the TTAB disagreed. [FN171] Although it did acknowledge that the “MOONIES” trademark might be “perceived as referencing members of the Unification Church,” [FN172] the TTAB ultimately found that “when used on a doll [the trademark] would most likely be perceived as indicating that the doll ‘moons’.” [FN173] Accordingly, the findings of the PTO were reversed, and the trademark was granted registration on the Principal Register. [FN174]

The TTAB was not as secular in its consideration of the religious trademark at issue in *P.J. Valckenberg, GmbH*. In that case, registration of the trademark “MADONNA” was denied by the PTO “on the ground that “MADONNA,” as applied to wines, is scandalous within the purview of Section 2(a) of the Act of 1946.” [FN175] The applicant *680 seeking registration of the trademark subsequently appealed to the TTAB. [FN176] The TTAB began its opinion by noting the similarities between Section 2(a) of the Lanham Act and its predecessor, Section 5 of the Trade-Mark Act of 1905. [FN177] Implicitly adopting the meaning of “scandalous” as used in the earlier statute, the TTAB concluded that the trademark “MADONNA” was not scandalous per se. [FN178] When used in association with an alcoholic beverage such as wine, though, the TTAB concluded that the trademark would be “scandalous” within the meaning of Section 2(a). [FN179] Thus, the TTAB upheld the decision of the PTO. [FN180]

The arbitrariness of Section 2(a) jurisprudence is further evidenced when *Steven Hershey* is considered in conjunction with *Runsdorf*. In *Steven Hershey*, the trademark “BIG PECKER BRAND” was denied registration under Section 2(a) after the PTO concluded “that ‘pecker’ is a slang or vulgar expression for ‘penis’ as evidenced by dictionary definition.” [FN181] *Hershey* appealed to the TTAB, arguing that “the term ‘pecker’, as used by the applicant, refers to a chicken or rooster.” [FN182] Unmoved by the PTO’s reference to slang dictionaries and “six articles retrieved from the NEXIS database where the term is used to refer to a penis,” [FN183] the TTAB held that the term “pecker” as used in the trademark would not be recognized by a “substantial composite of the general public [as being scandalous].” [FN184] Accordingly, the decision of the PTO denying registration of *Hershey*’s trademark was reversed, and the trademark was granted federal registration. [FN185]

A different result was reached in regards to the sexual trademark at issue in *Runsdorf*. In that case, an application sought to register the trademark “BUBBY TRAP” for women’s brassieres. [FN186] The PTO, however, denied registration of the trademark under Section 2(a) after consulting a definition of “bubby” provided by Webster’s Third New International Dictionary and finding that the trademark “would be offensive to [the] public or [an] individual sense of propriety or *681 morality.” [FN187] Before the TTAB, the applicant argued that another dictionary, the Oxford Universal Dictionary on Historical Principles, “define[d] ‘bubby’ as ‘[a] woman’s breast’ without reference to vulgarity and that in any event one cannot equate the term ‘vulgar’ with ‘scandalous’.” [FN188] The TTAB, however, disagreed and concluded that “‘vulgar,’ as defined, means, inter alia, lacking in

taste, indelicate, morally crude, and can, in our opinion, be encompassed by the term scandalous matter.” [FN189] Thus, the PTO’s refusal to register the trademark was affirmed. [FN190]

The aforementioned cases are only a few of the many examples of Section 2(a)’s historically inconsistent application. The seemingly whimsical application of that Section is largely the result of the inability of those considering the meaning of Section 2(a) to agree upon a single standard against which to measure the character of an applicant’s trademark. Until the various approaches used to interpret the terms of Section 2(a) are harmonized, cases brought under that Section will continue to turn on the subjective judgment of those evaluating the character of an applicant’s trademark. Such an approach can only lead to the arbitrary results evidenced by cases like *In Over Our Heads*, *P.J. Valckenberg, GmbH*, *Steven Hershey*, and *Runsdorf*. Thus, Section 2(a), as it currently exists, also violates the arbitrary and discriminatory element of the Void for Vagueness Doctrine.

B. Policy Elements

As discussed in Part I, several policy considerations also influence the successful application of the Void for Vagueness Doctrine. Here again, when the constitutionality of Section 2(a) is weighed in consideration of these factors, one can only conclude that this Section violates the Void for Vagueness Doctrine.

1. Principal Considerations

At its most basic level, the Void for Vagueness Doctrine serves as a judicial restraint on the state’s ability to regulate conduct. [FN191] As the Court explained in *Roberts*, the Constitution’s prohibition against statutory vagueness ensures that the state will exercise power “only on behalf of policies reflecting an authoritative choice among competing social values.” [FN192] Undoubtedly, Congress is well within its power to deny some trademarks the benefits of federal registration. It may not do so, however, without first articulating what types of trademarks are so prohibited. Indeed, by failing to effectuate this purpose with “a reasonable degree of clarity,” [FN193] this policy has been impermissibly delegated to unelected officials. As such, the blanket exclusion in Section 2(a) violates the most basic policy supporting the Void for Vagueness Doctrine.

2. First Amendment Matters

As the Court noted in *Button*, the Void for Vagueness Doctrine is particularly applicable to those laws impacting an individual’s First Amendment rights. [FN194] It is unclear, however, whether Section 2(a) has such freedom of speech implications. Indeed, when considering the issue in *McGinley*, the CCPA held that “[n]o conduct is proscribed, and no tangible form of expression is suppressed.” [FN195] Other courts considering the issue, citing *McGinley*, have reached the same conclusion. [FN196] Even so, the Court has made it clear that “a property interest in a means of communication does not enlarge or diminish the First Amendment protection of that communication.” [FN197] Arguably, a trademark is both an interest in property and a form of commercial expression. As such, it is illogical to conclude that the denial of federal registration does not have at least a de minimis impact on an applicant’s First Amendment rights.

3. Civil Law-Criminal Law Distinction

The Void for Vagueness Doctrine has traditionally been applied only to criminal statutes. [FN198] As such, many commentators have summarily dismissed the potential applicability of the Void for Vagueness Doctrine to Section 2(a) on this fact. [FN199] To interpret void for vagueness *683 jurisprudence so narrowly, however, is a mistake. Indeed, the Court itself has noted that application of the Void for Vagueness Doctrine is not dependent upon the nature of the challenged statute, but rather the quality of the standard imposed by the provision. [FN200] Furthermore, while the sanctions imposed by Section 2(a) do not rise to the level of those imposed by a criminal statute, the denial of those benefits accompanying the federal registration is a substantial penalty suffered by an applicant whose trademark is refused registration under that Section. [FN201] Thus, it is unclear how the civil law-criminal law distinction will affect the application of the Void for Vagueness Doctrine to Section 2(a).

4. State Law-Federal Law Distinction

Traditionally, only state statutes have been invalidated under the Void for Vagueness Doctrine. [FN202] Even so, it is unlikely that this distinction would prevent Section 2(a) from being invalidated on void for vagueness grounds. Both the Lanham Act and its legislative history are silent as to the meanings of “scandalous” and “disparag[ing].” [FN203] Moreover, those considering the issue have yet to define the inherently vague terms used in that Section adequately. As such, if asked to consider the applicability of the Void for Vagueness Doctrine to Section 2(a), the Court would have few adequate sources from which to give the terms in that Section any meaning. Therefore, this historical distinction is largely inapplicable to the issue of Section 2(a)'s constitutional vagueness.

IV. CONCLUSION

In conclusion, the terms of Section 2(a) are impermissibly vague, and, as such, that Section is unconstitutional under the Void for Vagueness Doctrine. Although a contrary conclusion was reached by the CCPA in *McGinley*, the court did so summarily and without any *684 reference to the factors traditionally considered in a void for vagueness analysis. When considered in light of the substantive elements of the Void for Vagueness Doctrine and those policy considerations historically shaping void for vagueness jurisprudence, it is clear that Section 2(a) is unconstitutional. Indeed, the inability of those considering the meaning of “scandalous” and “disparag[ing]” to articulate sufficiently a single standard against which to measure the character of an applicant's trademark, has ultimately led to the arbitrary and discriminatory application of that Section. Therefore, if challenged, Section 2(a) would surely fail on void for vagueness grounds.

[FNal]. J.D., Louis D. Brandeis School of Law at the University of Louisville (2003); B.A., Centre College (2000). The phrase “Today's Scandal Can Be Tomorrow's Vogue,” as used in the title of this Article, can be attributed to language used by the U.S. Court of Appeals for the Federal Circuit in the case of *In re Mavety Media Group, Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). The author would like to thank each member of the Howard Law Journal, but especially Ms. Tegra Watkins, for their help in the editing and publication of this Article. The author would like to thank his parents, Diane and Hershel Wright, and his grandparents, Paula and Ed Cochran, as this Article would not have been possible without their love and support throughout the years. Although she is anything but scandalous or

disparaging, this Article is for Julia.

[FN1]. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 2:18 (4th ed. 2003).

[FN2]. 15 U.S.C. §§ 1051-1129 (2000).

[FN3]. See id. § 1052.

[FN4]. Id. § 1052(a).

[FN5]. See U.S. Const. amend. V, § 2; id. amend. XIV, § 1, cl. 3.

[FN6]. 269 U.S. 385 (1926).

[FN7]. Id. at 391 (citing *Int'l Harvester Co. v. Kentucky*, 234 U.S. 216, 221 (1914); *Collins v. Kentucky*, 234 U.S. 634 (1914)).

[FN8]. David W. Gartenstein & Joseph F. Warganz, Note, *RICO'S "Pattern" Requirement: Void for Vagueness?*, 90 Colum. L. Rev. 489, 514 (1990). Although the Gartenstein and Warganz article deals exclusively with the language of the Racketeer Influenced and Corrupt Organizations Act (RICO), 18 U.S.C. §§ 1961-1968 (1988), "pattern requirement," the summary of the Supreme Court's void for vagueness jurisprudence therein is exceptional and as such is cited throughout much of the duration of this Section of this Article.

[FN9]. Gartenstein & Warganz, *supra* note 8, at 514.

[FN10]. Id. at 512.

[FN11]. Id. at 512-13.

[FN12]. Id. at 513.

[FN13]. *Colten v. Kentucky*, 407 U.S. 104, 110 (1972); see also Gartenstein & Warganz, *supra* note 8, at 513.

[FN14]. See Gartenstein & Warganz, *supra* note 8, at 513; see also *Cline v. Frink Dairy Co.*, 274 U.S. 445, 458 (1927).

[FN15]. 274 U.S. 445.

[FN16]. Id. at 458; see *United States v. Cohen Grocery Co.*, 255 U.S. 81, 87 (1921) (finding Section 4 of the Lever Act to be unconstitutionally void for vagueness); see also Gartenstein & Warganz, *supra* note 8, at 513.

[FN17]. Gartenstein & Warganz, *supra* note 8, at 513.

[FN18]. Id.

[FN19]. *City of Chicago v. Morales*, 527 U.S. 41, 60 (1999) (citing *Kolender v. Lawson*, 461 U.S.

352, 358 (1983)).

[FN20]. 407 U.S. 104 (1972).

[FN21]. *Id.* at 110; see also Gartenstein & Warganz, *supra* note 8, at 514.

[FN22]. See Gartenstein & Warganz, *supra* note 8, at 513.

[FN23]. See *Hurtado v. California*, 110 U.S. 516, 536 (1884); see also Gartenstein & Warganz, *supra* note 9, at 515.

[FN24]. 110 U.S. 516 (1884) (holding that a conviction for murder based upon information, and after examination and commitment by a magistrate, but without indictment by a grand jury, does not violate the Fourteenth Amendment).

[FN25]. *Id.* at 536; see also Gartenstein & Warganz, *supra* note 8, at 515.

[FN26]. See generally *Kolender v. Lawson*, 461 U.S. 352, 357-58 (1983); Gartenstein & Warganz, *supra* note 8, at 515.

[FN27]. *Kolender*, 461 U.S. 352.

[FN28]. *Id.* at 358; see also Gartenstein & Warganz, *supra* note 8, at 515-16.

[FN29]. *Kolender*, 461 U.S. at 352-53; see also Gartenstein & Warganz, *supra* note 8, at 516.

[FN30]. *Kolender*, 461 U.S. at 361; see also Gartenstein & Warganz, *supra* note 8, at 516.

[FN31]. *Grayned v. City of Rockford*, 408 U.S. 104, 108-09 (1972); see also Gartenstein & Warganz, *supra* note 8, at 505.

[FN32]. See Gartenstein & Warganz, *supra* note 8, at 505-13.

[FN33]. 408 U.S. 104.

[FN34]. *Id.* at 108-09.

[FN35]. 468 U.S. 609 (1984).

[FN36]. *Id.* at 629.

[FN37]. See Gartenstein & Warganz, *supra* note 8, at 505.

[FN38]. See *id.* at 506.

[FN39]. *Grayned v. City of Rockford*, 408 U.S. 104, 109 (1972).

[FN40]. 371 U.S. 415 (1963).

[FN41]. *Id.* at 433.

[FN42]. *Id.* at 432-33 (citations omitted).

[FN43]. Gartenstein & Warganz, *supra* note 8, at 509.

[FN44]. *Id.*

[FN45]. *Id.*

[FN46]. *Id.*

[FN47]. *A.B. Small Co. v. American Sugar Ref. Co.*, 267 U.S. 233, 239 (1925); see also Gartenstein & Warganz, *supra* note 8, at 510.

[FN48]. See Gartenstein & Warganz, *supra* note 8, at 510-11.

[FN49]. *Id.* at 511-12.

[FN50]. *Id.*

[FN51]. *Wainwright v. Stone*, 414 U.S. 21-23 (1973) (per curiam); see also Gartenstein & Warganz, *supra* note 8, at 511.

[FN52]. See *Crowell v. Benson*, 285 U.S. 22, 62 (1932); see also Gartenstein & Warganz, *supra* note 8, at 511.

[FN53]. Gartenstein & Warganz, *supra* note 8, at 511.

[FN54]. See *United States v. Rumely*, 345 U.S. 41, 47 (1953).

[FN55]. 15 U.S.C. §§ 1051-1129 (2000).

[FN56]. *Id.* § 1052(a).

[FN57]. See Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 *Trademark Rep.* 661, 664-65 (1993). The scope of Section 2(a) has long been debated because, as Baird points out, “[e]xactly what constitutes scandalous or immoral matter is difficult to define because it may vary depending upon who is asked, when they are asked, and where they are asked.” *Id.*

[FN58]. 15 U.S.C. § 1051.

[FN59]. See *id.* § 1062(a); see also Theodore H. Davis, Jr., *Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man's Vulgarity Be Another's Registered Trademark*, 54 *Ohio St. L.J.* 331, 335-37 (1993) (providing a concise overview of the federal registration process).

[FN60]. Davis, *supra* note 59, at 335.

[FN61]. *Id.*; see also U.S. Patent and Trademark Office, U.S. Department of Commerce Trademark Manual of Examining Procedure § 806.01(a)-(d), at 800-29 to 800-32 (7th ed. 2003) (stating the re-

quirements for establishing a basis for registration).

[FN62]. Davis, *supra* note 59, at 335-36.

[FN63]. *Id.*; see U.S. Patent and Trademark Office, *supra* note 62, § 1200 (enumerating the many substantive reasons why an application to the PTO might be denied).

[FN64]. Davis, *supra* note 59, at 335.

[FN65]. See 15 U.S.C. § 1062(b) (2000); see also Davis, *supra* note 60, at 336.

[FN66]. 15 U.S.C. § 1062(b); see also Davis, *supra* note 59, at 336.

[FN67]. 15 U.S.C. § 1062(b); see also Davis, *supra* note 59, at 336.

[FN68]. Davis, *supra* note 59, at 336.

[FN69]. See *id.*

[FN70]. *Id.*

[FN71]. J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 19.40[1], at 19-214 (3d ed. 1996); see also Davis, *supra* note 59, at 336.

[FN72]. See 37 C.F.R. § 2.80 (2003); see also Davis, *supra* note 59, at 337.

[FN73]. Davis, *supra* note 59, at 335.

[FN74]. *Id.* at 335-37.

[FN75]. See 15 U.S.C. §§ 1061, 1063(a) (2000); Davis, *supra* note 59, at 337.

[FN76]. See 15 U.S.C. § 1070; Davis, *supra* note 60, at 336.

[FN77]. James E. Hawes, Trademark Registration Practice § 1.11, at 1-20 to 1-20.1 (2d ed. 2003); see also Davis, *supra* note 60, at 336.

[FN78]. Hawes, *supra* note 77, at 1-20 to 1-20.1; see also Davis, *supra* note 59, at 336.

[FN79]. See C.F.R. § 2.144 (2003); Davis, *supra* note 59, at 336.

[FN80]. Davis, *supra* note 59, at 336.

[FN81]. See 15 U.S.C. § 1071(a) (2000); see also Davis, *supra* note 59, at 337.

[FN82]. However, it is uncertain whether the Court would be willing to grant certiorari to such a claim.

[FN83]. 15 U.S.C. § 1052(a).

[FN84]. The Lanham Act was first enacted into law on July 5, 1946.

[FN85]. 95 F.2d 327 (C.C.P.A. 1938).

[FN86]. *Id.* at 328.

[FN87]. *Id.*

[FN88]. *Id.*

[FN89]. *Id.*

[FN90]. *Id.*

[FN91]. *Id.* at 329.

[FN92]. Davis, *supra* note 59, at 351.

[FN93]. *Bromberg v. Carmel Self Serv., Inc.*, 198 USPQ 176 (T.T.A.B. 1978); *In re Runsdorf*, 171 USPQ 443 (T.T.A.B. 1971).

[FN94]. 198 USPQ 176.

[FN95]. *Id.* at 178.

[FN96]. *Id.*

[FN97]. *Id.*

[FN98]. *Id.* at 177, 179.

[FN99]. See *In re Runsdorf*, 171 USPQ 443 (T.T.A.B. 1971).

[FN100]. *Id.*

[FN101]. *Id.* at 444.

[FN102]. Cameron Smith, Note, Squeezing the Juice(R) out of the Washington Redskins(R): Intellectual Property Rights in “Scandalous” and “Disparaging” Trademarks After *Harjo v. Pro-Football Inc.*, 77 Wash. L. Rev. 1295, 1306 (2002); see also *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

[FN103]. 33 F.3d 1367 (Fed. Cir. 1994).

[FN104]. Smith, *supra* note 102, at 1306; see also *Mavety Media*, 33 F.3d at 1371.

[FN105]. *Mavety Media*, 33 F.3d at 1368, 1369, 1375.

[FN106]. Justin G. Blankenship, Note, The Cancellation of Redskins As a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words That Offend?, 72 U. Colo. L. Rev. 415, 435-36 (2001).

[FN107]. 6 USPQ2d 1635 (T.T.A.B. 1988).

[FN108]. *Id.* at 1639.

[FN109]. *Id.* (citing *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983)).

[FN110]. *Id.* at 1640.

[FN111]. *Id.*

[FN112]. 660 F.2d 481 (C.C.P.A. 1981).

[FN113]. *Id.* at 482.

[FN114]. *Id.*

[FN115]. *Id.* at 482.

[FN116]. *Id.*

[FN117]. *Id.* at 483.

[FN118]. *Id.*

[FN119]. See *id.* at 487.

[FN120]. *Id.* at 484.

[FN121]. *Id.*

[FN122]. *In re McGinley*, 660 F.2d 481, 487 (C.C.P.A. 1981).

[FN123]. *Id.* at 484.

[FN124]. *Id.* at 485.

[FN125]. *In re Mavety Media*, 33 F.3d 1367, 1368-69 (1994).

[FN126]. *Id.* at 1369.

[FN127]. *Id.*

[FN128]. *Id.*

[FN129]. *Id.* Mavety Media also argued that several trademarks registered with the PTO consisted of “[w]ords with non-sexual primary meanings that nonetheless had sexual connotations.” *Id.*

[FN130]. *Id.*

[FN131]. *Id.* at 1370.

[FN132]. Id.

[FN133]. Id.

[FN134]. Id.

[FN135]. *In re Mavety Media*, 33 F.3d 1367, 1374 (1994) (citations omitted). In a parenthetical reference to McGinley, however, the court adopted the conclusion of the C.C.P.A. that “[n]o conduct is proscribed [by Section 2(a)], and no tangible form of expression is suppressed.” Id.

[FN136]. Id.

[FN137]. Id.

[FN138]. Id. at 1375.

[FN139]. See 30 USPQ2d 1828, 1829 (T.T.A.B. 1994) (Harjo I).

[FN140]. Id. at 1829.

[FN141]. Id. at 1829. As such, Harjo sought cancellation of the Redskins' trademark decades after it had been initially registered with the PTO on the grounds that the trademark violated Section 2(a). See id.

[FN142]. Id. at 1830.

[FN143]. Id. at 1833.

[FN144]. Id.

[FN145]. *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1749 (T.T.A.B. 1999) (Harjo II).

[FN146]. *Pro-Football, Inc. v. Harjo*, 57 USPQ2d 1140 (D.D.C. 2000) (Harjo III).

[FN147]. Id. at 1142.

[FN148]. Id. at 1143.

[FN149]. Id. at 1146.

[FN150]. Id. at 1143. As the court noted, “this ‘fundamental rule of judicial restraint’... requires federal courts to pursue nonconstitutional avenues for decision ‘[p]rior to reaching any constitutional questions.’” Id. (citing *Three Affiliated Tribes of Berthold Reservation v. World Eng'g*, 467 U.S. 138, 157 (1984); see *Gulf Oil Co. v. Bernard*, 452 U.S. 89, 99 (1981)).

[FN151]. *Pro-Football, Inc. v. Harjo*, 284 F.Supp.2d 96, 145 (D.D.C. 2003) (Harjo IV).

[FN152]. Id.

[FN153]. See *In re McGinley*, 660 F.2d 481, 484-87 (C.C.P.A. 1981).

[FN154]. See *supra* Part II.

[FN155]. See *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371, 1374 (Fed. Cir. 1994).

[FN156]. Gartenstein & Warganz, *supra* note 8, at 512-13.

[FN157]. See *City of Chicago v. Morales*, 527 U.S. 41, 60 (1999) (citing *Kolender v. Lawson*, 461 U.S. 352, 358 (1983)).

[FN158]. 15 U.S.C. § 1052(a) (2000). That is, when drafting the Lanham Act, Congress failed to provide any formal definitions for its terms.

[FN159]. See Baird, *supra* note 57, at 671-72. As Baird notes, “[i]t is not clear from the language of [the Lanham Act], its legislative history, or the case law interpreting the statute, exactly whose perceptions must be considered when making a Section 2(a) determination.” *Id.*

[FN160]. See *In re Riverbank Canning Co.*, 95 F.2d 327, 327-29 (C.C.P.A. 1938); see also *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981).

[FN161]. As is evidenced by the Riverbank Canning and Bromberg cases discussed in *supra* Part II, there currently exists a split of authority as to whether the terms of Section 2(a) are to be considered as they would have been when the Lanham Act was first passed into law or rather should be given a more contemporary meaning.

[FN162]. “To be sure, appellate judges are a part of the composite of the general public, but they represent only a tiny fraction of the whole, which necessarily encompasses a wondrous diversity of thought. Although constantly at odds, progressive views and conservative or traditional thinking participate alike in the formation of the composite of the general public.” *In re Mavety Media Group Ltd.*, 33 F.3d 1367 (Fed. Cir. 1994).

[FN163]. *In re In Over Our Heads*, 16 USPQ2d 1653, 1654 (TTAB 1990) (quoting *In re Hershey*, 6 USPQ2d 1470, 1471 (TTAB 1988)).

[FN164]. “To appreciate the extreme changes in social mores over time, one need only glance at a historical survey of Board decisions regarding refusals to register marks containing particular words deemed scandalous.” *Mavety Media*, 33 F.3d at 1371-72. Compare *In re Old Glory Condom Corp.*, 26 USPQ2d 1216 (TTAB 1993) (“OLD GLORY CONDOM CORP,” with stars and stripes design on condoms suggesting the American flag, not scandalous), *In re In Over Our Heads Inc.*, 16 USPQ2d 1653 (TTAB 1990) (“MOONIES” on dolls, whose pants can be dropped to expose their buttocks, not scandalous), *In re Hershey*, 6 USPQ2d 1470 (TTAB 1988) (“BIG PECKER BRAND” on T-shirts not scandalous), *In re Leo Quan Inc.*, 200 USPQ 370 (TTAB 1978) (“BADASS” for bridges of stringed musical instruments not scandalous), *In re Madsen*, 180 USPQ 334 (TTAB 1973) (“WEEK-END SEX” on magazines not scandalous), *In re Hepperle*, 175 USPQ 512 (TTAB 1972) (“ACAPULCO GOLD” on suntan lotion not scandalous), and *Ex parte Parfum L’Orle, Inc.*, 93 USPQ 481 (Pat. Off. Exam’r-in-Chief 1952) (“LIBIDO” on perfumes not scandalous), with *In re Tinseltown, Inc.*, 212 USPQ 863 (TTAB 1981) (“BULLSHIT” on personal accessories scandalous), *In re Runsdorf*, 171 USPQ 443 (TTAB 1971) (“BUBBY TRAP” for brassieres scandalous), *In re Sociedade Agricola E. Comer-*

ical Dos Vinhos Messias, S.A.R.L., 159 USPQ 275 (TTAB 1968) (“MESSIAS” on wine and brandy scandalous), *In re Reemtsma Cigarettenfabriken G.m.b.H.*, 122 USPQ 339 (TTAB 1959) (“SENUSSI” on cigarettes scandalous), *In re P.J. Valckenberg, GmbH*, 122 USPQ 334 (TTAB 1959) (“MADONNA” on wine scandalous), *Ex parte Summit Brass & Bronze Works, Inc.*, 59 USPQ 22 (TTAB 1943) (“AGNUS DEI” on metallic tabernacle safes scandalous), *In re Riverbank Canning Co.*, 95 F.2d 327, 37 USPQ 268 (CCPA 1938) (“MADONNA” on wine scandalous), and *Ex parte Martha Maid Mfg. Co.*, 37 USPQ 156 (Comm'r Pats.1938) (“QUEEN MARY” on women's underwear scandalous)).

[FN165]. 16 USPQ2d 1653.

[FN166]. 122 USPQ 334.

[FN167]. 6 USPQ2d 1470.

[FN168]. 171 USPQ 443.

[FN169]. *In Over Our Heads*, 16 USPQ2d at 1653.

[FN170]. *Id.* at 1654.

[FN171]. *Id.* at 1654-55.

[FN172]. *Id.* at 1654.

[FN173]. *Id.*

[FN174]. *Id.* at 1655.

[FN175]. *In re PJ Valckenberg, GmbH*, 122 USPQ 334 (TTAB 1959).

[FN176]. *Id.*

[FN177]. *Id.* at 334-35.

[FN178]. *Id.* at 334.

[FN179]. *Id.* at 334-35.

[FN180]. *Id.* at 335.

[FN181]. *In re Hershey*, 6 USPQ2d 1470 (TTAB 1988).

[FN182]. *Id.* at 1471.

[FN183]. *Id.*

[FN184]. *Id.*

[FN185]. *Id.* at 1472.

[FN186]. *In re Runsdorf*, 171 USPQ 443 (TTAB 1971).

[FN187]. *Id.* Webster's Third New International Dictionary defined "'bubby' as 'Breast, now often considered vulgar.'" *Id.*

[FN188]. *Id.*

[FN189]. *Id.* at 444.

[FN190]. *Id.*

[FN191]. See generally Gartenstein & Warganz, *supra* note 8.

[FN192]. *Roberts v. United States Jaycees*, 468 U.S. 609, 629 (1984).

[FN193]. *Id.*

[FN194]. *NAACP v. Button*, 371 U.S. 415, 432-33 (1963).

[FN195]. *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981).

[FN196]. See *In re Mavety Media*, 33 F.3d 1367 (1994).

[FN197]. *Friedman v. Rogers*, 440 U.S. 1, 13 n.11 (1979).

[FN198]. See Gartenstein & Warganz, *supra* note 8, at 509.

[FN199]. See Baird, *supra* note 57, at 682-83. Baird claims that the Void for Vagueness Doctrine: is most properly applied in situations where statutes absolutely prohibit certain vaguely defined conduct, declare such conduct unlawful, and subject violators to criminal prosecution. Because none of those situations are present with respect to Section 2(a), the scandalous prong of that section properly survived the due process challenge in *McGinley*.

Id. at 682.

[FN200]. See *A. B. Small Co. v. American Sugar Ref. Co.*, 267 U.S. 233, 239 (1925).

[FN201]. These benefits include, *inter alia*, *prima facie* evidence of validity and the owner's exclusive right to use the trademark, which may become incontestable after five years, constructive use, and the ability to stop the importation of articles bearing an infringing trademark. See 15 U.S.C. §§ 1057, 1065, 1115, 1124 (2000).

[FN202]. See Gartenstein & Warganz, *supra* note 8, at 510.

[FN203]. See 15 U.S.C. § 1052(a).

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